

## REMARKS

### **I. Introduction**

Claims 1 to 33 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO Form-1449 and cited references.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all copies of the certified copies of the priority documents have been received.

### **II. Rejection of Claims 11 to 29 Under 35 U.S.C. § 112, Second Paragraph**

Claims 11 to 29 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Final Office Action alleges that it is unclear how the two fiber types are structurally related in the tufted backing. Applicants respectfully submit that the present claims satisfy the requirement of 35 U.S.C. § 112 for the following reasons.

The second paragraph of 35 U.S.C. § 112 merely requires that the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. As provided in M.P.E.P. § 2173.02, the “focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision.” In this regard, the “essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” *Id.* (emphasis added). “Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, *inter alia*, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *Id.* If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more.

M.P.E.P. § 2173.05(a) (citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

Applicants respectfully submit that claim 11 reasonably clearly conveys to one skilled in the art that portions of a spunbonded nonwoven having fibers or filaments having a titer of 6 to 15 dtex are bonded by needling and that portions of the spunbonded nonwoven having a titer of 1 to 5 dtex are bonded by either water jets alone or using a combination of waters jets and needling.

The Final Office Action alleges that it is unclear if the fibers are blended in a single layer, if separate layers contain fibers of each titer range, or if the different fibers are arranged in different adjacent sections of a single layer. Claim 11 claims a method for making a spunbonded nonwoven. The claim does not limit the resulting product, i.e., the spunbonded nonwoven, to one having a specific arrangement with respect to the arrangement of the fibers. Rather, one skilled in the art would recognize that the spunbonded nonwoven may comprise, for example, layers with a blend of both larger and smaller fibers or layers with only large or small fibers so long as the limitations of the claim are met, namely, fibers or filaments having a titer of 6 to 15 dtex are bonded by needling and that fibers or filaments with a titer of 1 to 5 dtex are bonded by either water jets alone or using a combination of waters jets and needling. Applicants respectfully submit that the prior art does not require that the claim be limited to a method of making a tufted backing having a specific arrangement with respect to the fibers. Further, one skilled in the art at the time of the invention would have understood that the tufted backing could be made with blended layers, i.e., including a mix of larger and smaller fibers, and/or with layers having either the larger or the smaller fibers. The Examiner is respectfully reminded that Applicants are not claiming a specific tufted backing configuration. Rather, the claims are directed to a method for making a tufted backing, having any configuration, so long as the limitations of the claim are met.

Regarding claims 21 to 24, 26 and 27, the Final Office Action alleges that the phrase “and a 5% modulus value in the machine direction of [x] N/5 cm, but at least [y] N/gm<sup>2</sup>” is indefinite because of the use of different units. As an initial matter, Applicants have amended claims 30 and 31 to replace N/gm<sup>2</sup> with Nm<sup>2</sup>/g, which are consistent with modulus units. With respect to the use of different units, Applicants respectfully submit that the claims would have been reasonably clear to one of ordinary skill in the art at the time of filing. In this regard the Examiner is

referred to page 6 of the Specification, which indicates that the conversion is 1 Nm<sup>2</sup>/g per 91 N/5 cm.

In light of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 11 to 29.

### **III. Rejection of Claims 11 to 29 Under 35 U.S.C. § 112, First Paragraph**

Claims 11 to 29 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the Specification in such a way as to enable one skilled in the art to make and/or use the invention. In particular, the Examiner stated that the Specification “does not disclose how to make the invention as claimed (i.e., bonding fibers of a *first* titer in a *portion* of a spunbonded nonwoven by needling and bonding fibers of a *second* titer in a *second portion* with water jets and/or needling).” Applicants respectfully submit that the present claims fully satisfy the requirements of 35 U.S.C. § 112 for the following reasons.

Since the rejections under the first paragraph of 35 U.S.C. § 112 concern enablement, it is respectfully submitted that the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See *id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of

experimentation needed to make or use the invention based on the disclosure. (See *id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01). It is respectfully submitted that the Final Office Action has not addressed these factors.

Importantly, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See *id.* (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See *id.*).

It is believed that the present assertions of the Final Office Action do not meaningfully address -- as they must under the law -- whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation -- which it plainly does. In short, it is believed that the Final Office Action’s arguments and assertions do not really address the issue of whether one having ordinary skill would have to *unduly experiment* to practice the claimed subject matter of the rejected claims -- a proposition for which the Office bears the burden of proving a *prima facie* case as to the rejected claims.

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of *Ex Parte Reese*, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner’s subjective belief that the specification was not enabling as to the claims. In particular, it is respectfully submitted that the subjective assertions of the Final Office Action are simply not supported by any real “evidence or sound scientific

reasoning” -- which the law requires and which makes plain that the Office (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in *Ex parte Reese* was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation -- which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See *id.* ). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner’s ‘Response to Argument’ is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See *id.* at 1222 & 1223; italics in original).

In the present case, it is respectfully submitted that the Final Office Action has not satisfied the foregoing for establishing that undue experimentation would be required.

The Final Office Action alleges that the specification “does not explain how the two different fibers types are structurally related in the nonwoven.” The Final Office Action further alleges that the Specification “does not disclose two portions and how said portions are structurally related in the spunbond nonwoven. Based on the foregoing the Examiner concludes that the claims are not enable because one skilled in the art would not be able to make the invention as claimed without undue experimentation.

Applicants respectfully disagree and submit that one skilled in the art would not have to unduly experiment to practice the present invention, as recited in claim 11. It is respectfully submitted that one skilled in the art would have recognized that a tufted backing may take on many configurations, e.g., including blended layers including both large and small fibers mixed and/or layers including only large or small fibers, etc., depending the particular use of the tufted backing. Therefore, one skilled in the art need not unduly experiment to make the invention as claimed. One need only choose a particular configuration for a tufted backing, consistent with the design requirements of the particular use and familiar to one

skilled in the art, and follow the steps of claim 11. Claim 11 recites the steps of bonding fibers using needling and/or water jets as well as the steps of stretching, drying and thermosetting the bonded fibers. Applicants respectfully submit that these processes are familiar to one skilled in the art, and therefore, one skilled in the art would not have to unduly experiment to make a tufted backing utilizing such processes. As indicated above, the method of claim 11 is not limited to a specific configuration of tufted backing rather the method applies to all tufted backings having fibers in the range of 1 to 5 dtex and fibers in the range of 6 to 15 dtex, so long as the limitations of the claim are met.

The Final Office Action asserts that the working example does not employ fibers of two titer ranges and the abstract only mentions one range and relies on such to support its lack of enablement argument. Applicants respectfully submit that the fact that working example and/or abstract do not discuss two titer ranges is of absolutely no consequence. Original claim 11 as well as, for example, the Specification at p.3, lines 23 to 30, discuss a tufted backing including fibers of two titer ranges.

In light of all the foregoing, Applicants respectfully request withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 11 to 29.

#### **IV. Rejection of Claims 11 to 33 Under 35 U.S.C. § 112, First Paragraph**

Claims 11 to 33 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Final Office Action alleges that the claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully submit that the present claims fully satisfy the requirements of 35 U.S.C. § 112 for the following reasons.

As an initial matter, the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added). The Manual of Patent Examining Procedure also provides that if an examiner rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described”

and provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). However, the written description requirement is not an in haec verba requirement. That is, “the specification ‘need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.’” All Dental Prodx LLC v. Advantage Dental Products Inc., 64 U.S.P.Q.2d 1945, 1948 (Fed. Cir. 2002) (quoting Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995)). Moreover, a “failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” All Dental Prodx, 64 U.S.P.Q.2d at 1948 (citing Eiselstein, 52 F.3d at 1039, 34 U.S.P.Q.2d at 1470). An applicant can show “possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” M.P.E.P. § 2163 (citing Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997)).

The Final Office Action alleges that Specification, as originally filed, does not provide support for the claim recitation “of at least one” in line 3 of claim 11. Applicants respectfully disagree for the following reasons. As admitted by the Final Office Action, the working example discloses a tufted backing including fibers in the range of 1 to 5 dtex, i.e., 4.3 dtex. See Final Office Action at par. 7 and the Specification, for example, at p. 4, lines 22 to 32. Therefore, there is support for a tufted backing having fibers in the range of 1 to 5 dtex. See also, for example, p. 3, lines 26 to 27. Applicants respectfully further submit that original claim 11, as well as the Specification, provide support for a tufted backing having both filaments in the range of 1 to 5 dtex as well as filaments in the range of 6 to 15 dtex. See for example, at p. 3, lines 23 to 30, which states:

The method according to the invention for manufacturing a tufted backing of thermoplastic polymer fibers or filaments processed into a spunbonded nonwoven is characterized in that the fibers or filaments having a titer of 6 to 15 dtex are bonded by needling and the fibers or filaments having a titer of 1 to 5 dtex are bonded by using water jets or by a combination of these methods, and before drying and

thermosetting, they are stretched by up to 30% in the longitudinal direction, the mobility of the fibers optionally being improved by the addition of oil or some other finish.

Applicants respectfully submit that the above reference discloses the use of two range of fiber sizes in a tufted backing, fibers from the range of 1 to 5 dtex as well as fibers in the range of 6 to 15 dtex. Therefore, the application, as originally filed, provides support for both a tufted backing having fibers only in the range of 1 to 5 dtex as well as a tufted backing having fibers in both a first range of 1 to 5 dtex and in a second range of 6 to 15 dtex. The above reference, which formed part of the application as originally filed, also provides support for the specific type of bonding used for each fiber size range. Therefore, it would have been clear to one skilled in the relevant art that the inventors at the time filing had possession of the invention as claimed, namely, “at least one of bonding fibers or filaments having a titer of 6 to 15 dtex . . . by needling, and bonding fibers or filaments having a titer of 1 to 5 dtex. . . by using one of water jets and a combination of water jets and needling.”

The Final Office Action further alleges that the Specification does not provide support for the claimed “portions” of the spunbond nonwoven having different titers. As detailed above, the Specification discloses a tufted backing having fibers from two different range sizes, 1 to 5 dtex and 6 to 15 dtex. See, for example, the Specification at p.3 lines 25 to 7 (emphasis added), which states that “fibers or filaments having a titer of 6 to 15 dtex are bonded by needling and the fibers or filaments having at titer of 1 to 5 dtex are bonded by using . . .” The Specification also teaches bonding the fibers in the different ranges differently, e.g., 1 to 5 dtex using water jets and 6 to 15 dtex using either water jets and a combination of water jets and needling. Using a different bonding process for the different fiber size ranges, as per the claim, necessarily results in a tufted backing having different portions. Consider, for example, the situation where water jets are used for the fibers in the 1 to 5 dtex range and the combination of water jets and needling is used for fibers in the 6 to 15 dtex range. Applicants respectfully submit that one skilled in the relevant art, even without use of the word “portion” in the Specification, would recognize that this method produces a tufted backing having different portions, one portion produced by water jets alone and the other portion produced by a combination of water jets and needling. Therefore, addition of the language “portion” and “another portion” does not constitute new matter.


Accordingly, Applicants respectfully submit that claims 11 to 33 fully comply with the requirements of 35 U.S.C. § 112, first paragraph, and withdrawal of this rejection is therefore respectfully requested.

**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: November 24, 2004



---

Richard M. Rosati (Reg. No. 31,792)  
KENYON & KENYON  
One Broadway  
New York, NY 10004  
P: (212) 908-~~6408~~ 6472  
F: (212) 425-5288  
**Customer No. 26646**